TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application No.	09/902,060
Filing Date	July 9, 2001
First Named Inventor	Roger Collins
Art Unit	2819
Examiner Name	Wamsley, P.
Attorney Docket Number	5545P001

Total Number of Pages in This Submission	19

ENCLOSURES *(check all that apply)*

☒ Fee Transmittal Form

   ☒ Fee Attached

☐ Amendment / Response

   ☐ After Final
   ☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

   ☐ PTO/SB/08

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/ Incomplete Application

   ☐ Basic Filing Fee
   ☐ Declaration/POA
   ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert a Provisional Application

☐ Power of Attorney, Revocation Change of Correspondence Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s)

☐ After Allowance Communication to Group

☐ Appeal Communication to Board of Appeals and Interferences

☒ Appeal Communication to Group **(Appeal Notice, Brief, Reply Brief)**

☐ Proprietary Information

☐ Status Letter

☐ Other Enclosure(s) *(please identify below):*

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Mark L. Watson, Reg. No. 46,322 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	
Date	

CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Typed or printed name	**April Worley**		
Signature		Date	**July 16, 2004**
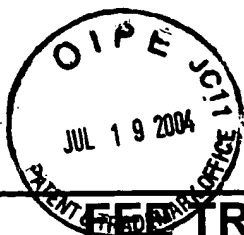
FEE TRANSMITTAL
for FY 2004
Effective 01/01/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT	($)	330.00

Complete if Known	
Application Number	09/902,060
Filing Date	July 9, 2001
First Named Inventor	Roger Collins
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Art Unit	2819
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METHOD OF PAYMENT *(check all that apply)*

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
☐ Deposit Account

Deposit Account Number: **02-2666**

Deposit Account Name: **Blakely, Sokoloff, Taylor & Zafman LLP**

The Commissioner is authorized to: *(check all that apply)*

☒ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) or underpayment of fees as required under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Fee ($)	Small Entity Fee Code	Fee ($)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) ($)

2. EXTRA CLAIM FEES

	Extra Claims	Fee from below	Fee Paid
Total Claims	___ - 20** = ___	X ___ =	
Independent Claims	___ - 3 = ___	X ___ =	
Multiple Dependent		=	

Large Entity Fee Code	Fee ($)	Small Entity Fee Code	Fee ($)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple Dependent claim, if not paid
1204	86	2204	43	**Reissue independent claims over original patent
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($)

**or number previously paid, if greater. For Reissues, see below

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Fee ($)	Small Entity Fee Code	Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
2053	130	2053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for *ex parte* reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1404	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330.00
1403	290	2403	145	Request for oral hearing	
1451	1,510	2451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	2460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	1809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

_____

* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) ($) 330.00

SUBMITTED BY

		Complete (if applicable)	
Name *(Print/Type)*	**Mark L. Watson**	Registration No. *(Attorney/Agent)*	**46,322**
		Telephone	**(303) 740-1980**
Signature		Date	

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)		
	)		
Collins et al.	)	Examiner:	Wamsley, Patrick G.
	)		
Application No: 09/902,060	)	Art Unit:	2819
	)		
Filed: July 9, 2001	)		
	)		
For: System and Method for Compressing	)		
Data on a Bandwidth-Limited	)		
Network	)		

APPEAL BRIEF
IN SUPPORT OF APPELLANT'S APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

Appellant hereby submits this Brief in triplicate in support of its appeal from a
final decision by the Examiner, mailed February 18, 2004, and within the two-month
period following a notice of appeal filed on May 18, 2004, in the above-referenced
Application. Appellant respectfully requests consideration of this appeal by the Board of
Patent Appeals and Interferences for allowance of the above-captioned patent application.

An oral hearing is not desired at this time.

07/21/2004 HALI11   00000013 09902060
01 FC:1402   330.00 OP

TABLE OF CONTENTS

I.   REAL PARTY IN INTEREST

The invention is assigned to Good Technology, Inc., currently of 1032 Morse
Avenue, Sunnyvale, California 94089.

II.   RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge, there are no appeals or interferences
related to the present appeal that will directly affect, be directly affected by, or have a
bearing on the Board's decision.

III.   STATUS OF THE CLAIMS

Claims 1, 3, 11, 13, 21 and 24 stand rejected under 35 U.S.C. §102(b) as being
anticipated by European Patent 806,858 of Szlam ("*Szlam*") in the Final Office Action
mailed February 18, 2004. Claims 4-9, 14-19 and 25-30 stand rejected under 35 U.S.C.
§103(a) as being unpatentable over *Szlam* in view of the Admitted Prior Art ("*APA*").
Claims 1, 3-9, 11, 13-19, 21 and 24-30 are the subject of this appeal.

IV.   STATUS OF AMENDMENTS

In response to the Final Office Action mailed on February 18, 2004, a notice of
Appeal was filed on May 18, 2004. A copy of all claims on appeal is attached hereto as
an Appendix of Claims.

V. SUMMARY OF THE INVENTION

According to one embodiment, a method for compressing an electronic mail message is disclosed. The method includes identifying a block of data within the electronic mail message which is found in a previous electronic mail message, generating a pointer identifying the block of data in said previous electronic mail message, replacing the block of data in the electronic mail message with the pointer, and transmitting the electronic mail message to a wireless data processing device having the previous electronic mail message stored thereon.

In another embodiment, a system includes message identification logic for identifying a previous electronic mail message which contains a block of data found in a new electronic mail message, state-based compression logic for compressing the new electronic mail message by replacing the block of data with a pointer identifying the block of data in the previous electronic mail message, and transmission logic for transmitting the new electronic mail message to a wireless data processing device having the previous electronic mail message stored thereon.

In yet a further embodiment, a method is disclosed that provides an interface to a message service that compresses messages and forwards the compressed messages to a wireless data processing device. The interface compresses an electronic mail message by searching for prior electronic mail messages transmitted to or received from the wireless data processing device which include a block of data found in the electronic mail message and replaces the block of data with a pointer to the block of data in the prior electronic mail messages. The electronic mail message is then transmitted to a wireless data processing device having the previous electronic mail message stored.

VI.   ISSUES PRESENTED

1. Whether claims 1, 3, 11, 13, 21 and 24 are patentable over *Szlam*; and

2. Whether claims 4-9, 14-19 and 25-30 are patentable over *Szlam* in view of

APA;

VII.   GROUPING OF CLAIMS

The claims stand or fall together.

For the purposes of this appeal Claims 1, 3-9, 11, 13-19, 21 and 24-30 stand or

fall together as Group I.

VIII. ARGUMENT

Claim Group I

A. THE PENDING CLAIMS WERE IMPROPERLY REJECTED UNDER 35 U.S.C. §102(B) BECAUSE *SZLAM* DOES NOT DISCLOSE IDENTIFYING A BLOCK OF DATA WITHIN AN ELECTRONIC MAIL MESSAGE THAT IS FOUND IN A PREVIOUS ELECTRONIC MAIL MESSAGE

Appellant respectfully submits that *Szlam* fails to disclose the claimed invention for the reasons set forth below.

Each claim in Claim Group I recites an element that is not disclosed in *Szlam*.

For example, Appellant's Claim 1 recites the following:

> A method for compressing an electronic mail message comprising:
> identifying a block of data within said electronic mail message which is found in a previous electronic mail message;
> generating a pointer identifying said block of data in said previous electronic mail message;
> replacing said block of data in said electronic mail message with said pointer; and
> transmitting said electronic mail message to a wireless data processing device, said wireless data processing device having said previous electronic mail message stored thereon.

Appellant's Claim 11 recites:

> A system comprising:
> message identification logic for identifying a previous electronic mail message which contains a block of data found in a new electronic mail message;
> state-based compression logic for compressing said new electronic mail message by replacing said block of data with a pointer identifying said block of data in said previous electronic mail message; and
> transmission logic for transmitting said new electronic mail message to a wireless data processing device, said wireless data processing device having said previous electronic mail message stored thereon.

Appellant's Claim 21 recites:

> A method comprising:
> providing an interface to a message service, said interface compressing messages and forwarding said compressed messages to a wireless data processing device,
> wherein said interface compresses an electronic mail message by searching for prior electronic mail messages transmitted to or received from said wireless data processing device which include a block of data found in said electronic mail message and replacing said block of data with a pointer to said block of data in said prior electronic mail messages; and
> transmitting said electronic mail message to a wireless data processing device, said wireless data processing device having said previous electronic mail message stored.

Szlam discloses a call center that features a method for identifying, aggregating, routing, storing, tracking, and retrieving related information and resources deployed through multiple contacts or steps of a single transaction or through multiple transactions within a single process. A Composite Call transaction record (composite record) is disclosed that comprises objects that can include and/or point to transitory voice and data connections, sequence of events, and other multi-media components such as documents, voice annotations, video clips, and images. Thus, ACD/PBX call handling is provided in the sense that Composite Calls can be transferred, forwarded and conferenced, such that voice connection, data connection, as well as other components or segments are of record. See *Szlam* at col. 6, ll. 27-45.

Each composite record includes a plurality of segments, with each new event adding another segment. For example, a composite record will be created and the first segment created when a first agent or task (machine driven or originated) accesses the customer information. An example of a task that may access information is an automated dialing operation. The first segment will include the information on the identity of the

first agent/task and the address of the customer information. The information in a segment may be all of the information available in a database, databases, hosts, servers, or applications, regarding a particular person or thing. The first segment may contain this information and may also contain one or more pointers, which specify the location of this information or other information (col. 13, ll. 52 – col. 14, ll. 32).

Szlam also discloses that the creation of a Composite Call Object is initiated in response to a transaction, call, communication, or some other action. The action may be the placement of an outbound call, or the arrival of an inbound call, or the sending or receipt of a facsimile message or an electronic mail message, or the sending or receipt of a voicemail message, etc. (col. 14, ll. 33-41).

Appellant submits that there is no disclosure in *Szlam* of identifying a block of data within an electronic mail message, which is found in a previous electronic mail message. The Examiner asserts that:

> . . . Szlam's call center, as admitted by applicant on page 7, features a method for identity related information and resources. This method corresponds to the recited step of identifying a block of data within an electronic mail message, because Szlam's information includes email.

See Final Office Action at page 4, first paragraph.

Appellant strongly disagrees with the Examiner's assertion that *Szlam* discloses a process of identifying a previous electronic mail message which contains a block of data found in a new electronic mail message. *Szlam* simply discloses that a composite object may be created upon receiving a transaction, which may be an email transaction. *Szlam* does not disclose the particular contents of such emails. Further, *Szlam* fails to disclose any type of relationship between two or more emails. As a result, there is absolutely no

disclosure in *Szlam* of identifying, or searching for, a prior email that has a block of data that is found in a new email.

For the foregoing reasons, Appellant submits that the Examiner has failed to search and find a printed publication or patent that discloses the claimed invention as set forth in MPEP § 706.02(a).

Claims 3-9, 13-19 and 24-30 depend from claims 1, 11 and 21, respectively. Given that dependent claims necessarily include the limitations of the claims from which they depend, Appellant submits that the invention as claimed in claims 3-9, 13-19 and 24-30 are similarly not anticipated by *Szlam*.

Thus, the Examiner erred in rejecting claims 1, 3, 11, 13, 21 and 24 under U.S.C. § 102(b).

B. THE PENDING CLAIMS WERE IMPROPERLY REJECTED UNDER 35 U.S.C. § 103(A) BECAUSE NEITHER *SZLAM* NOR THE *APA* DISCLOSE OR SUGGEST IDENTIFYING A BLOCK OF DATA WITHIN AN ELECTRONIC MAIL MESSAGE THAT IS FOUND IN A PREVIOUS ELECTRONIC MAIL MESSAGE

The Claims of Claim Group I are not obvious in view of *Szlam* in view of *APA* under 35 U.S.C. § 103(a).

The *APA,* which is included in the Background section of Appellants Specification, discloses that various data techniques, such as Lempel-Ziv-Welch (LZW) compression, is used to compress data prior to transmission over a wireless network. See Specification at page 2, lines 16-20. However, the Background does not disclose or suggest identifying a block of data within an electronic mail message which is found in a previous electronic mail message.

As discussed above, *Szlam* does not disclose or suggest such a feature. As a result, any combination of Szlam and Appellants' Background would also not disclose or suggest identifying a block of data within an electronic mail message which is found in a previous electronic mail message, or transmitting the electronic mail message to a wireless data processing device having the previous electronic mail message stored thereon

For the foregoing reasons, Appellant submits that the Examiner has failed to establish a *prima facie* case of obviousness as set forth in MPEP § 706.02(j). Specifically, the Examiner has failed to show that "[t]he teaching or suggestion to make the claimed combination ... [is] found in the prior art, and not based on Appellant's disclosure," as required by <u>In re Vaeck</u>, 947 F.2d 488 (Fed. Cir. 1991).

Thus, the Examiner erred in rejecting claims 4-9, 14-19 and 25-30 under 35 U.S.C. § 103(a) in view of *Szlam* and *APA*.

IX. CONCLUSION

Careful review of the Examiner's rejections shows that the Examiner has failed to provide any reference, or combination of references of the prior art that shows all of the elements of each appealed claim. Therefore, Appellant respectfully submits that all appealed claims in this application are patentable and were improperly rejected by the Examiner during prosecution before the United States Patent and Trademark Office. Appellant respectfully requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

This brief is submitted in triplicate, along with a check for $330.00 to cover the appeal fee for one other than a small entity as specified in 37 C.F.R. § 1.17(c). Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: _____   _____
Mark L. Watson
Reg. No. 46,322

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA. 90025-1026
(408) 720-8598

X.   APPENDIX OF CLAIMS (37 C.F.R. § 1.192(c)(9))

The claims on appeal read as follows:

1.   A method for compressing an electronic mail message comprising:

identifying a block of data within said electronic mail message which is found in a previous electronic mail message;

generating a pointer identifying said block of data in said previous electronic mail message;

replacing said block of data in said electronic mail message with said pointer; and

transmitting said electronic mail message to a wireless data processing device having said previous electronic mail message stored thereon.

3.   The method as in claim 1 further comprising:

decompressing said electronic mail message by inserting said block of data from said previous electronic mail message into said electronic mail message.

4.   The method as in claim 1 further comprising:

identifying said previous electronic mail message based on characters in a subject field of said message.

5.   The method as in claim 4 wherein said characters include text indicating that said electronic mail message is a response to said previous electronic mail message.

6.   The method as in claim 1 further comprising:

compressing said electronic mail message further using one or more alternate compression techniques.

7.   The method as in claim 6 wherein one of said alternate compression techniques comprises:

replacing common strings of characters with one or more code words.

8.   The method as in claim 7 wherein one of said strings of characters is an electronic mail (email) address domain.

9.   The method as in claim 1 further comprising:

encoding portions of text in said electronic mail message not in said block of data using 6-bits per character.

11.   A system comprising:

message identification logic for identifying a previous electronic mail message which contains a block of data found in a new electronic mail message;

state-based compression logic for compressing said new electronic mail message by replacing said block of data with a pointer identifying said block of data in said previous electronic mail message; and

transmission logic for transmitting said new electronic mail message to a wireless data processing device having said previous electronic mail message stored thereon.

13.   The system as in claim 11 further comprising:

decompression logic to decompress said new electronic mail message on said wireless data processing device by inserting said block of data from said previous electronic mail message into said new electronic mail message.

14.   The system as in claim 11 wherein said message identification logic identifies said previous electronic mail message based on characters in a subject field of said new electronic mail message.

15. The system as in claim 14 wherein said characters include text indicating that said new electronic mail message is a response to said previous electronic mail message.

16. The system as in claim 11 further comprising:

one or more alternate compression modules for compressing said new electronic mail message further using one or more alternate compression techniques.

17. The system as in claim 16 wherein one of said alternate compression modules comprises:

a code word generation module which replaces common strings of characters with one or more code words.

18. The system as in claim 17 wherein one of said strings of characters is an electronic mail (email) address domain.

19. The system as in claim 16 wherein one of said alternate compression modules comprises a 6-bit text encoding module to encode portions of text in said new electronic mail message not in said block of data using 6-bits per character.

21. A method comprising:

providing an interface to a message service, said interface compressing messages and forwarding said compressed messages to a wireless data processing device,

wherein said interface compresses an electronic mail message by searching for prior electronic mail messages transmitted to or received from said wireless data processing device which include a block of data found in said electronic mail message and replacing said block of data with a pointer to said block of data in said prior electronic mail messages; and

transmitting said electronic mail message to a wireless data processing device having said previous electronic mail message stored.

24.   The method as in claim 21 further comprising:

decompressing said electronic mail message at said wireless data processing device by inserting said block of data from said previous electronic mail message into said electronic mail message.

25.   The method as in claim 21 wherein said interface identifies said previous electronic mail message based on characters in a subject message of said electronic mail message.

26.   The method as in claim 25 wherein said characters include text indicating that said electronic mail message is a response to said previous electronic mail message.

27.   The method as in claim 21 wherein said interface further compresses said electronic mail message further using one or more alternate compression techniques.

28.   The method as in claim 27 wherein one of said alternate compression techniques comprises:

replacing common strings of characters with one or more code words.

29.   The method as in claim 28 wherein one of said strings of characters is an electronic mail (email) address domain.

30.   The method as in claim 21 wherein said interface further compresses said electronic mail message by encoding portions of text in said electronic mail message not in said block of data using 6-bits per character.